

REMARKS

Election/Restrictions

Newly submitted claims 27-29 are allegedly directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: The new limitation of a mask added by claims 27-29 requires a different field of search than the originally presented claims.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 27-29 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Applicant traverses the election/restriction. Furthermore, Applicant respectfully submits that claims 27-29 are dependent on claim 1 and do not require a different field of search than the originally presented claim. According to MPEP 808.02(C), under “A different field of search”, the Examiner must show by appropriate explanation that:

it is necessary to search for one of the inventions in a manner that is not likely to result in finding art pertinent to the other invention(s) (e.g., searching different classes/subclasses or electronic resources, or employing different search queries, a different field of search is shown, even though the two are classified together. The indicated different field of search must in fact be pertinent to the type of subject matter covered by the claims. Patents need not be cited to show different fields of search.

The Examiner, however, has not provided an explanation as to why it is necessary to search for one of the inventions in a manner that is not likely to result in finding art pertinent to the other inventions. Thus, under MPEP 808.02 no restriction/election should have been given, “where, however, the classification is the same and the field of search is the same and there is no clear indication of separate future classification and field of search, no reasons exist for dividing among independent or related inventions”.

Accordingly, Applicant respectfully requests the withdrawal of the election/restriction requirement of claims 27-29.

Claim Rejections - 35 USC § 102

Claims 1, 2, 4, and 25 rejected under 35 U.S.C. 102(b) as being allegedly anticipated by Kashihara (US 5,742,317). Applicant respectfully traverses this rejection.

Claim 1 - Response to Arguments

Claim 1 recites, in part, “halftone dots having sizes according to tone values”. The Examiner asserts:

In response to applicant's arguments, the recitation “halftone dots having sizes according to tone values” has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. *See In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

Applicant respectfully submits that the Examiner's old cases are not pertinent in view of recent cases that are directly on point. The determination of whether a preamble limits a claim is made on a case-by-case factually or legally basis in light of the facts in each case. Dependence on a preamble recitation to provide antecedent basis for a claim term appearing in the body indicates a reliance on both the preamble and body to define the invention. *Bell Communications Research, Inc. v. Vitalink Communications Corp.*, 55 F.3d 615, 620, 34 USPQ2d 1816, 1820 (Fed. Cir. 1995).

In the present invention, the feature, “halftone dots having sizes according to tone values” is necessary to give life, meaning, and vitality to the “halftone dot conversion section” of claim 1. As recited in claim 1, the “halftone dot conversion apparatus” comprises “a halftone dot conversion section that forms *the halftone dots*” where the antecedent basis for the halftone dots is in the preamble of claim 1. Based on the Federal Circuit precedent, Applicant respectfully submits that the Examiner must consider “halftone dots having sizes according to tone values” as recited in claim 1.

Furthermore, the Examiner alleges that Kashiara discloses 1. Applicants respectfully submit that this position is not supportable.

The Examiner asserts that the “halftone dots” of the claimed invention is disclosed by the supercell matrix feature of Kashiara. The supercell of Kashiara is disclosed by FIGS. 3 and 4 of Kashiara and col. 10, line 50 of Kashiara, where:

the interpolation circuit 18 refers to the image signals of the peripheral pixels around a target pixel M and converts into signals a, b, c, and d in which the densities in the main scan and sub scan directions are twice as large as those of the image signal for the target pixel M.

The Examiner appears to interpret the supercell as an example of the “halftone dot” of the claimed invention. However, the “halftone dot” of the claimed invention is defined by “having sizes according to the tone values” as recited in claim 1. Therefore, the “halftone dot” of the claimed invention, by its dimensions, may correspond to each halftone dot appearing in a supercell. Assuming *arguendo*, even if the individual halftone dots in the supercell are interconnected and form a group, this group as a whole does not disclose the halftone dot of the claimed invention because the size of the entire group or supercell cannot change according to the tone values. Thus, Kashihara does not disclose or suggest “halftone dots having sizes according to the tone values”.

Because claim 1 is generic to the elected and non-elected species and is allowable for the reasons set forth above, we would request rejoinder of the withdrawn claims.

Claim 2

Claim 2 recites, in part, “the halftone dot conversion section always scatters the blanks of the drawing pixels about the halftone dots, at associated positions, respectively, ***regardless of the tone values.***” The Examiner alleges that Kashihara would anticipate claim 2. Applicant respectfully submits that this position is not supportable.

The Examiner asserts that, “FIG. 17 shows 4 blank pixels for all 16 tone values ranging 0-15. Kashihara states that the tone values range from 0 to 15 at column 11, line 9” discloses the above recited features. In Kashihara, in case of an image of ***a uniform tone***, the binarized result repeats ***the same pattern***. Accordingly, the binarized dither patterns are ***varied based on the tone value***. (See col. 16, lines 12-14 and lines 20-22). Thus, Kashihara does not disclose or suggest “the halftone dot conversion section always scatters the blanks of the drawing pixels about the halftone dots, ***at associated positions***, respectively, ***regardless of the tone values***” as recited in claim 2. The fill pattern of Kashihara has non-filled blanks in areas that directly depend on the value. The teachings of Kashihara are the complete opposite of claim 2. Claims 27-29 are merely more detailed embodiments of how to achieve the scatter ***at associated points regardless of tone value***. Therefore, claims 2 and 27-29 are all patentable.

Claim Rejections - 35 USC § 103

Claims 8 and 22 are rejected under 35 U.S.C. 103(a) as being allegedly unpatentable over Kashihara. Applicant respectfully traverses this rejection.

Claim 8

The Examiner contends that Kashihara teaches plural conversion systems. However, each of the fill patterns of FIGS. 6, 17, and 20 relate to *alternative* embodiments. The apparatus of Kashihara would not include multiple fill patterns but, at best, *one* such pattern. The Examiner may not alter or combine embodiments without a basis to do so. Ex parte Beuthes (71 USPQ2d 1313, 1316, BPAI 2003).

Claim 22


For analogous reasons regarding the patentability of claim 1, claim 22 is also patentable over the prior art on rejoinder of all withdrawn claims due to our designation of claims 1 and 22 as generic.

Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,


Theodore C. Shih
Registration No. 60,645

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE

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